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OFFICE OF PETITIONS

In re Application of :
Vogeli, et al. : DECISION ON PETITION
Application No. 09/801,944 :
Filed: 8 March, 2001 :
Attorney Docket No. 00100.US1 :

This is a decision on the papers filed on 4 August, 2003, under 37 C.F.R. §1.137(b) to revive the above-identified application as abandoned due to unintentional delay, and in light of the allegations (timely filing in response to the Notice of Incomplete Reply) considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.

NOTE: It is noted that the mailing address utilized by Counsel/Petitioner herein is different from that of record in the Office, and further that no Notice of Change of Address is apparent of record.

If Petitioner desires to receive future correspondence regarding this application to the mailing address in Petitioner's most recent papers, the appropriate Notice must be submitted. A courtesy copy of this decision will be mailed to Petitioner.

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

The petition as considered under:

- 37 C.F.R. §1.181 is **DISMISSED**; and

- 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates that:

- Petitioner Gwilym Attwell (Reg. No. 45,449) alleges that the application was deposited in US Postal Service (USPS) Express Mail service on 8 March, 2001, under Express Mail No. EL568028411US, but due to Office error, the return receipt card incorrectly reflected both the application number¹ and the filing date;
- after the date-stamped receipt card was returned by the Office to Petitioner with not only an incorrect file number but also an erroneous filing date of 28 February, 2001, Petitioner filed a petition on 16 April, 2001, seeking to obtain the 8 March, 2001, filing date;
- in the meantime the filing receipt was mailed on 20 July, 2001, and reflected the filing date of 8 March, 2001, and application number (09/801,944), and--as a result-- the 16 April, 2001, petition was dismissed as moot on 20 August, 2001;
- however, in separate mailing on 20 July, 2001, the Office forwarded to Petitioner a Notice of Missing Parts (Filing Date Granted) addressing the unsigned oath/declaration, as well as the damaged computer-readable disk--moreover, the Notice also indicated that pages 72 - 78 of the specification (description and claims) appeared to be missing from the application, and Petitioner either could:
 - accept the filing date of 8 March, 2001, without pages 72 - 78 of the specification (description and claims) of the application, or
 - submit within two (2) months pages 72 - 78 of the specification (description and claims) of the application with a petition for its inclusion and accept the date of filing of that submission and petition;
- it appears that Petitioner may have attempted to file via USPS Express Mail (Label No. EL650276866US) a second petition regarding the filing date on 20 September, 2001, and while Petitioner's file copy of that paper now submitted carries no date stamp from the Office and there is neither a date-stamped receipt card or a date-stamped copy of the Express Mail label, the file does contain a copy of the Notice to File Missing Parts date

¹ Another serial number--that of 09/794,058, which was the application number for a now-patented case filed, in fact, on 28 February, 2001--appears erroneously on the receipt card identified with this Express Mail number and these inventors.

stamped as filed with the Office on 18 October, 2001, with a finance notation of a \$130.00 petition fee (and Office finance records also reflect payment for a one- (1-) month extension of time) paid by check and accounted for on 23 October, 2001;

- thereafter, a Notice of Incomplete Reply mailed on 22 January, 2002, set forth a filing date of 18 October, 2001;
- while the Notice of Incomplete Reply reminded Petitioner that the time period for reply to the original 20 July Notice to File Missing Parts, it also indicated that extensions of time were available;
- as reflected by a date-stamped receipt card, Petitioner filed a reply to the Notice of Incomplete Reply on 19 February, 2002, with the required items under the Notice, and therein Petitioner requested and authorized the fee for a five- (5-) month extension of time.

Those materials were not matched with the file at that time.

Notably, however, one item not apparently listed on any of the date-stamped receipt cards as having been filed of record prior to the 4 August, 2003, filing is the executed oath/declaration of the inventors.

Petitioner filed with the instant petition an additional copy of, *inter alia*, the computer readable disk and of the executed oath/declaration.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Allegations as to the Request to Withdraw
the Holding of Abandonment

Petitioner contends that, *inter alia*, the Office error as to the application number and the USPS treatment of mail in the wake of an anthrax attack triggered the abandonment. However, as is clear, Petitioner acknowledged receipt of the Notice of Missing Parts and simply failed to file timely the executed oath/declaration of record.

Because Petitioner alleges that the holding of abandonment was improper, the instant petition is considered in light of the regulations at 37 C.F.R. §1.181.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁸

Petitioner has alleged but failed to evidence that the Office improperly deemed the instant application abandoned, and thus fails to satisfy the requirements for having the holding of abandonment withdrawn.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

Moreover, a delay is not “unavoidable” when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.⁹

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹⁰

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹¹

Petitioner simply failed to file a timely and proper response to the Notice.

Such practice clearly does not satisfy the Pratt requirements of diligence in attending to one’s most important business affairs.

Allegations as to the Petition to Revive
Following Unintentional Delay

Petitioner has filed the petition (with fee), submitted the reply to the Notice of Missing Parts (disk and oath/declaration), and made the statement of unintentional delay.

Petitioner has satisfied the requirements of a petition under 37 C.F.R. §1.137(b).

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

Because Petitioner has satisfied the requirements of 37 C.F.R. §1.137(b), the petition hereby is **granted**.

⁹ See MPEP 711.03(c)(III)(C)(2).

¹⁰ Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (Comm’r Pat. 1887) (the term “unavoidable” “is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business”); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (Comm’r Pat. 1913).

¹¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

The instant application is being forwarded to OIPE for correction of data regarding filing date issues addressed in separate decision. Thereafter, the file will be forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to be "John J. Gillon, Jr.", written in a cursive style.

John J. Gillon, Jr.
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